

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Pinnacle Bancorp, Inc.
Mark: PINNBANK 24-HOUR ONLINE
BANKING and design
Serial No. 76/022950
Filing Date: April 11, 2000
Exam. Atty: Robert Clark
Law Office: 108
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Assistant Commissioner for Trademarks
2900 Crystal Drive, South Tower
Arlington, VA 22202-3513



05-15-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

APPLICANT'S APPEAL BRIEF

INTRODUCTION

Pinnacle Bancorp, Inc. ("Applicant") appeals the Examining Attorney's refusal to register the mark PINNBANK 24-HOUR ONLINE BANKING (and design) under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) because Applicant's mark so resembles the mark shown in U.S. Registration No. 2,309,164 as to be likely, when used on the identified services, to cause confusion, or to cause mistake, or to deceive.

As set forth in the following sections of this Appeal Brief, Applicant believes the Examining Attorney's contentions to be in error, and asks that this Board reverse the refusal and pass this mark to publication.

RELEVANT FACTS

Applicant filed its application on April 11, 2000 for the mark PINNBANK 24-HOUR ONLINE BANKING (and design) for "banking and financial services, namely, interactive and online banking services and residential mortgage and lending services offered to corporate and individual consumers via a global computer information

network" in class 36.

On September 22, 2000, registration was refused under Section 2(d), 15 U.S.C. Section 1052(d) because Applicant's mark was likely to be confused with the registered mark PINN PRO in U.S. Registration No. 1,309,164 ("Registrant's mark"). The Office Action also addressed issues regarding a disclaimer requirement and the indefinite wording in the recitation of services.

Applicant submitted arguments in support of registration and responded to the outstanding informalities in a communication dated March 21, 2001. On July 12, 2001, the Examining Attorney further expounded his position in a Final Office Action, elaborating on the similarities of the Applicant's and Registrant's marks and services.

Applicant's mark was deemed abandoned on March 14, 2002. Applicant filed a Petition to Revive and a Second Office Action Response on April 18, 2002. The Petition to Revive was granted on September 2, 2002. The Examining Attorney mailed a Continuation of Final Refusal on September 9, 2002.

In response, Applicant is filing this Appeal Brief. The sole issue on appeal is whether the Applicant's mark is likely to be confused with U.S. Registration No. 1,309,164.

ARGUMENT

Applicant's service mark PINNBANK 24-HOUR ONLINE BANKING (and design) for "banking and financial services, namely, interactive and online banking services and residential mortgage and lending services offered to corporate and individual consumers via a global computer information network" is not likely to be confused with the Registrant's mark PINN PRO for "financial services, namely, providing cash

management accounts" for the following reasons.

A. The Overall Commercial Impression of Applicant's Mark Is Sufficiently Dissimilar from that of Registrant's Mark.

By viewing the overall commercial impression of the mark PINNBANK 24 HOUR ONLINE BANKING in relationship to the named services, there will not be a likelihood of confusion between Applicant's Mark and Registrant's mark. The similarity of the marks with regard to appearance, sound, meaning, and commercial impression are important considerations. In re E.T. Du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity of the marks in one respect--sight, sound or meaning--will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. TMEP § 1207.01(b)(1). Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. Id. (citing In re Lamson Oil Co., 6 USPQ2d 1041, 1043 (TTAB 1987)).

1. Sight.

The marks do not look alike. Although the Applicant's Mark and Registrant's mark each incorporate the word "Pinn", the marks are quite dissimilar in appearance when taken in their entireties. See, e.g., Cluett, Peabody & Co., Inc. v. Savatux Facing Company, 277 F.2d 944, 945 (CCPA 1960) (holding that "the marks PROM and PROM PLAID have in common only the suggestive word "prom" which is not a sufficient basis for sustaining the opposition. The marks, taken in their entireties neither look nor sound alike nor do they convey the same meaning to a purchaser."). The Proposed mark is compromised of the stylized word PINNBANK with the words 24-HOUR ONLINE

BANKING inset in smaller type. The Registrant's mark is merely compromised of the two words PINN PRO. The Applicant asserts that the use of different and additional words and different and distinctive typesets are sufficient to eliminate any potential consumer confusion as to the source of the services offered under the respective marks.

Further, Applicant's mark is distinguishable from the Registered Mark by its use of a stylized design. The Registrant's mark appears only as the type-written phrase PINN PRO. However, Applicant's mark is comprised of the stylized word PINNBANK with the words 24-HOUR ONLINE BANKING inset in smaller type. Additionally, the Applicant's mark contains the distinctive use of a clock graphic displayed prominently behind the stylized type.

2. Meaning.

The marks do not have the same meaning. The dominant word in Applicant's mark is "PINNBANK", whereas the dominant word in Registrant's mark is merely "PINN". Applicant's mark also includes the phrase "24 HOUR ONLINE BANKING". The addition of the word "BANK" and the phrase "24 HOUR ONLINE BANKING" in Applicant's mark add the connotation of banking and online services entirely absent from Registrant's mark. This distinction in meaning is sufficient to distinguish, in the recollection of the average purchaser, Applicant's mark from Registrant's mark.

3. Sound.

Finally, the sound of the marks is dissimilar. Although the marks share the word "PINN", the words "PRO" and "BANK" are phonetically distinct. The addition of the phrase "24 HOUR ONLINE BANKING" in Applicant's mark further distinguishes the

sound of the marks.

Therefore, registration of Applicant's mark will not result in consumer confusion because prospective purchasers will not receive the same overall commercial impression from the Applicant's mark and the Registrant's mark.

B. Applicant's Mark and Registrant's Mark Travel in Distinct Channels of Trade.

The target markets and trade channels for the services offered under the Applicant's mark and Registrant's mark are sufficiently dissimilar to overcome any likelihood of confusion. Applicant's services provided in connection with its mark are relevant only to customers seeking to engage in the full spectrum of banking services on the Internet. As evidence of Applicant's efforts to focus its marketing efforts of the mark to online customers, Applicant submitted Internet search results for its mark. See *Internet Search Results attached to Applicant's Office Action Response*. As demonstrated by the Internet searches, the Applicant's web site, to which the mark is affixed, is the first web site listed on every set of search results and the first five to ten listings on each set of search results. In contrast, the services provided in connection with the Registered mark have not been marketed on the Internet and there is no indication they are available online. See *Internet Search Results attached to Applicant's Office Action Response*.

Further, Applicant's mark is only used in connection with its online services, and its description of services clearly incorporates this limitation. Since consumers can access Applicant's services only through Applicant's web site, which contains sufficient information for consumers to distinguish between Applicant's bank and any other bank,

including Registrant's, consumers are not likely to be confused as to the origin of the services provided in connection with Applicant's mark

C. Applicant's Services Are Sufficiently Unrelated to Registrant's.

The similarity or dissimilarity in the nature of the services offered under the marks is another important factor in the analysis of whether a likelihood of confusion exists between marks. See In re E.I. du Pont Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). While the services may both involve "financial services", there are significant differences between the services offered under the marks.

Registrant's services are expressly limited to "cash management accounts". Applicant respectfully requests that the TTAB take judicial notice of the following definition of "cash management account": "bank-type development of Merrill Lynch in partnership with Bank One of Ohio, based in Columbus, where affluent clients are offered a Visa credit card and checking to draw against their investment balances." Jerry M. Rosenberg, Dictionary of Banking (1993) (a copy of the definition is attached for convenience). See also 12 C.F.R. § 344.3(c) (defining a "cash management sweep account" as a "prearranged, automatic transfer of funds above a certain dollar level from a deposit account to purchase a security or securities, or any pre-arranged, automatic redemption or sale of a security or securities when a deposit account drops below a certain level with the proceeds being transferred into a deposit account"). Applicant, on the other hand, offers online banking services in connection with its mark. Applicant asserts that Registrant's specialized cash management accounts are distinctly different services than Applicant's online banking services.

D. The Purchasing Environments in Which the Applicant's and Registrant's Services Are Encountered Are Such That Confusion Between the Marks Is Not Likely.

The conditions under which the services are purchased--i.e., whether the services are purchased on impulse or whether they are purchased after careful, sophisticated consideration--is another factor relevant to determining whether a likelihood of confusion exists between two marks. See In re E.I. du Pont Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The nature of the services offered under both marks create a purchasing environment more appropriate to calculated purchasing than impulse buying; purchasers of Registrant's cash management account services or Applicant's online banking services are more likely to be interested in establishing an ongoing service relationship (e.g, an account) rather than participating in a single, one-time transaction. Therefore, they are more likely to consider, and affirmatively determine, the identity of the service provider.

Also, as discussed above, Registrant's services consist of highly specialized cash management accounts. Customers interested in such accounts are likely to be sophisticated consumers willing to establish an account with Registrant only after careful consideration. Similarly, Applicant's online banking services, while available to sophisticated and unsophisticated consumers alike, are simply not the type of services consumers purchase on impulse.

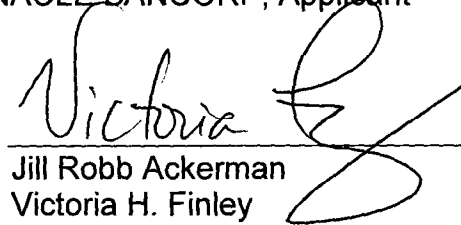
CONCLUSION

For the reasons set forth above, Applicant submits that there is no likelihood of confusion, mistake or deception between Applicant's mark and Registrant's mark. Accordingly, Applicant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Applicant's mark.

PINNACLE BANCORP, Applicant

By:

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cash dividend: declared dividends payable in cash, usually by check.

cash earnings: the profits or net income of an organization. These earnings include all depreciation and amortization accruals.

cashiered check: check accepted by a bank in exchange for cash. Usually such an item can be identified by a teller's stamp or cash-out symbol. [31]

cashier: a bank's officer or representative responsible for the custody of the bank's assets, and whose signature is required on official documents.

cashier's account: the ledger account of a bank that is primarily used to record cashier's checks.

cashier's check: a bank's own check signed by a cashier, becoming a direct obligation of the bank. Upon issue to a customer, it becomes a loan and a debit in the cashier's account. It differs from a certified check in that it is drawn against the funds of the bank itself, not against the funds found in a specific depositor's account. Cf. *certified check*, *register(ed) check*. Synonymous with *official check*, *treasurer's check*.

cash in vault: coin and currency actually held by the banks on their own premises. [40]

cash items: items listed in a firm's statement that are the equivalent of cash, such as bank deposits, government bonds, and marketable securities.

cash letter: a transit check with listing tapes, transmitting items from one bank to another for collection. Frequently, the items contained in the cash letter are grouped into several batches with a listing tape

attached to each batch. The totals are recapped on the transmittal form letter. Generally, these are associated with mail deposits received from other banks. [31]

cash letter of credit: a letter addressed by a bank to its correspondent bank to make available to the party named in the letter, funds up to a specified amount within certain time limitations. The sum named in the letter is deposited with the bank before the letter is issued, hence the designation *cash letter of credit*. [10]

cash loan: see *policy loan*.

cash management: payment and collection services to corporate customers to speed collection to receivables, control payments, and efficiently manage cash. [105]

cash management account (CMA): a bank-type development of Merrill Lynch in partnership with Bank One of Ohio, based in Columbus, where affluent clients are offered a Visa credit card and checking to draw against their investment balances. The account was initially offered in 206 of Merrill Lynch's 382 offices in the United States.

Cash Management Bill: U.S. Treasury bills introduced in 1975 to raise funds quickly for a short period; ranging from 9 to 20 days to maturity, with notice of their offering given up to 10 days ahead. All payment must be made in federal funds.

cash on hand: cash drawer money, vault cash, and demand deposits in commercial banks or regional Federal Home Loan Banks. [59]

cash over: a general ledger account to which tellers' cash overages are credited. See *cash over and short*. [10]

cash over and short: the difference between the cash on hand and the balance of the cash account in the cashbook. When the cash on hand is over the balance of the cash account or cashbook, the cash is over; when less than that of the balance, the cash is short.

cash paid receipt: receipt given a customer when making a bank card payment in cash. It contains the community office number, date of payment, and teller's initials. [105]

cash payment: a payment made in cash at a community office. [10]

cash payments journal: a special journal in which all cash payments, and only cash payments, are entered.

cash position: the percentage of cash to the total net assets; the amount after the deduction of current liabilities.

cash ratio:

- (1) the ratio of cash and related assets to liabilities.
- (2) the ratio of cash to total positive liabilities.
- (3) in Great Britain, deposits required by the Bank of England.

cash receipts journal: a special journal in which all cash receipts, and only cash receipts, are entered.

cash register: a machine used to provide an immediate record of each cash transaction by having a convenient place for sorting and keeping the funds used in daily transactions.

cash register totals: daily totals for all transactions; including cash sales, charge sales, receipts on account, and so on.

cash release ticket: a slip either handwritten or machine printed

CERTIFICATE OF EXPRESS MAILING

"Express Mail" mailing number:

Date of Deposit: May 15, 2003

I hereby certify that this Applicant's Appeal Brief on behalf of Pinnacle Bancorp, Inc., is being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, Box TTAB / No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513.

S. Lynne Bowes

(Typed or printed name of person mailing response)

A handwritten signature in black ink, appearing to read "S. Lynne Bowes", written over a horizontal line.

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Attention: Carl Kochersperger

Re: PINNBANK 24-HOUR ONLINE BANKING and design
Serial No. 76/022950
Examining Attorney: Robert Clark; Law Office 108

Dear Mr. Kochersperger:

We enclose the Applicant's Appeal Brief of Pinnacle Bancorp, Inc., with respect to the above-referenced mark. Please acknowledge receipt by date-stamping the enclosed postage-paid postcard and returning it to our office. If you have any questions, please contact us.

Thank you.

Very truly yours,

Victoria
Victoria H. Finley
FOR THE FIRM

VHF/slb
Enclosures

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